

P A T E N T

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Roger Farnholtz Confirmation No.: 9216
Serial No.: 10/804,360 Examiner: Aarti Bhatia
Filing Date: March 19, 2004 Group Art Unit: 3763
Docket No.: 1001.1690102 Customer No.: 28075
For: TORQUEABLE AND DEFLECTABLE MEDICAL DEVICE SHAFT

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 2nd day of October 2008.

By Kathleen L. Boekley
Kathleen L. Boekley

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached three sheets of arguments.

This Request is signed by an attorney or agent of record.

Respectfully submitted,

Roger Farnholtz

By his Attorney,

Date: 10/2/08

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Attachment: Three Sheets of Pre-Appeal Brief Request Attachment

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PRE-APPEAL CONFERENCE BRIEF

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Dear Sir:

Appellant has carefully reviewed the Final Office Action of June 13, 2008 and the Advisory Action of August 22, 2008. Currently, claim 19-22, 24-26, 28-35, 37 and 38 are pending and have been rejected in the Final Office Action. Appellant hereby requests a pre-appeal conference and files this Pre-Appeal Conference Brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

In the Advisory Action, the Examiner wrote that the request for reconsideration has been considered but does not place the application in condition for allowance because "although the arguments are valid, the claims as presented are not currently in condition for allowance, as inverting the overlapping members would be obvious to one having ordinary skill in the art." Appellant was perplexed that an argument admitted as valid by the Examiner should be unsuccessful. A review of the rejections in the Final Office Action supplies a theory as to why such an unusual rationale was supplied for denying the request for reconsideration. The primary rejection was an anticipation rejection under 35 U.S.C. §102, and over the reference Lundquist, USPN5228441. Appellant can only suppose that the Examiner found the response to the Final

Office Action that Lundquist does not anticipate the claims persuasive, but nonetheless considers the claims obvious over Lundquist. Appellant can think of no other likely rationale.

This being the case, the error in the Advisory Action is clear. The Examiner is apparently trying to introduce a new ground of rejection in the Advisory Action, an obviousness rejection under 35 U.S.C. §103 over Lundquist (the phrase "obvious to one having ordinary skill in the art" is not used in maintaining an anticipation rejection). This is clear error. A new ground of rejection may only be introduced by re-opening prosecution. See, for example, MPEP §706.07(e).

Appellant further notes that the rationale given for obviousness of "inverting the overlapping members would be obvious to one having ordinary skill in the art" would not be considered adequate by Appellant should the Examiner reopen prosecution and introduce the new ground of rejection. "The Federal Circuit has stated that 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" MPEP §2142 citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Here, the conclusory statement that "inverting the overlapping members would be obvious" cannot be supported by articulated reasoning. The two overlapping elements of Lundquist in question are a torque tube 31 and a braided tubular member 54. As shown in Figure 3, both elements have a uniform outer diameter and a uniform inner diameter, with the exception of some slots in torque tube 31. Torque tubes, in particular, are known to have a generally uniform outer diameter. This is significant to the discussion in light of another feature of the device of Lundquist. The outermost diameter of the device is defined by shrink tubing 46, the final dimensions of which are determined by the outer diameter of torque tube 31. Therefore, if one inverts the overlapping, puts braided element 54 over torque tube 31, one increases the maximum outer diameter of the device. The outer diameter of these types of intravascular devices is critical as the outer diameter is the dimension which limits what lumens the device can fit into. Increasing the outer diameter without any countervailing advantage being introduced produces a device that is less satisfactory for its intended purpose. Insofar as it may not be able to fit where it otherwise could have fit without the design change, the proposed modification may indeed render the prior art device unsatisfactory for its intended purpose. Appellant therefore

does not believe that the legal conclusion that certain claims are obvious over Lundquist can be reached on the basis of the facts gleaned from the prior art.

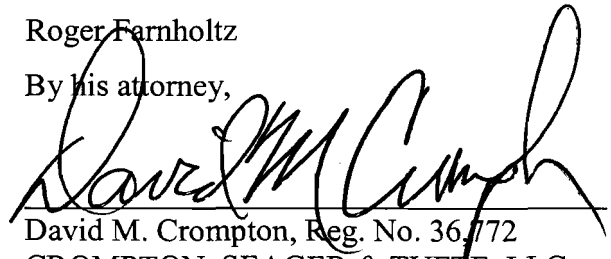
Because the rejections in the Final Office Action were apparently not maintained ("although the arguments are valid") and because no new ground of rejection can be introduced without reopening prosecution, Appellant understands the claims to be in the unusual state of neither being rejected or allowed. The attempt to introduce a new ground of rejection after prosecution has been closed is clear error. Therefore, as Appellant stated in the response of August 13, 2008, the claims are not anticipated by Lundquist (a statement with which the Examiner apparently agrees), and as stated above, Appellant does not believe the claims are obvious over Lundquist, Appellant believes that the claims are in condition for allowance.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Roger Farnholtz

By his attorney,



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